



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	020748.0104PTUS	9954

32042 7590 04/28/2005

PATTON BOGGS LLP
8484 WESTPARK DRIVE
SUITE 900
MCLEAN, VA 22102

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/425,739

Applicant(s)

PEYSER ET AL.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/8/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 10/7/2004, which was received 2/8/2005. Acknowledgement is made to the amendment to claim 8, leaving claims 1,2 and 4-9 as pending in the instant application. The applicant's remarks have been carefully considered and were found to be persuasive, however after further review a new grounds of rejection is provided below:

Claim Rejections - 35 USC § 112

Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case the specification lacks support and description for the two denying steps.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

Art Unit: 3625

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2 and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US 6,047,274).

In regards to claim 1, Johnson teaches the current invention of a computer-

implemented method for distributing products, but does not specifically mention that the product being distributed is a telecommunication service. Since the limitation of telecommunication service does not impart any functionality, this limitation is considered to be non-functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the distribution of any product.

storing in memory a set of responses to purchase requests for telecommunication services associated with a plurality of service providers (FIG 4, item 29),

each response reflecting at least one telecommunication service offering associated with one of the service providers and a related cost for the telecommunication service offering (FIG 6, bids);

establishing a session over a network for considering the purchase of telecommunication services (FIG 6);

receiving a purchase request at a computer on the network including information indicating a requested telecommunication service (FIG 6, item 42);

assessing the stored set of responses to purchase requests for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service (FIG 4, item 34); and

preventing a requester from accepting the response after the session is terminated (col 12, lines 47-55).

In regards to claim 2, Johnson teaches terminating the session, such that when the session is terminated the response can no longer be accepted (col 12, lines 5-55).

In regards to claim 4, Johnson teaches permitting access by service providers to the stored set of responses to purchase requests for telecommunication services (col 12, lines 37-44).

In regards to claim 5, Johnson teaches denying access by the service providers to the stored set of responses to purchase requests for telecommunication services during the session (col 6, lines 10-20).

In regards to claim 6, Johnson teaches denying access by a service provider, during the session, to at least one response of the stored set of responses to requests for telecommunication services, wherein the response to which access is denied is the same as the response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service (see response to claim 6).

In regards to claim 7, Johnson teaches permitting each service provider to modify the stored set of responses to requests for telecommunications services to reflect changes in the service provider's telecommunication service offerings (col 6, lines 30-36).

In regards to claim 8, Johnson discloses a telecommunication service providing system, comprising: a database containing a set of responses to purchase requests for telecommunication services, each response reflecting at least one telecommunication service offering associated with a service provider and a related cost for the telecommunication service offering;

a computer in communication with a network and the database, to establish a session for (i) receiving a purchase request on behalf of a buyer including

information indicating a requested telecommunication service for at least one consumer, (ii) accessing the stored set of responses to purchase requests for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service for the at least one consumer, (iii) receiving an acceptance to the response during the session and (iv) preventing the acceptance to the response after the session (see response to claim 1).

In regards to claim 8, Johnson discloses a computer-implemented method for purchasing telecommunication services during a session, the method comprising:

storing a set of responses in memory to purchase requests for telecommunication services, each response reflecting at least one telecommunication service offering associated with a service provider and a related cost for the telecommunication service offering:

receiving a purchase request at a computer on a network during the session including information indicating a requested telecommunication service;

accessing the stored set of responses to purchase requests during the session for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service; permitting a requestor to accept the at least one response during the session; and preventing the service provider from modifying the set of responses during the session (see response to claim 1).

Response to Arguments

Applicant's arguments, see response, filed 2/10/2005, with respect to the rejection(s) of claim(s) 1,2,4-9 under USC 102 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Johnson et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

Art Unit: 3625

(703) 872-9306 [Official communications; including

After Final communications labeled

"Box AF"]

(571) 273-6755 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a stylized, flowing script.

Mark Fadok

Patent Examiner